

Ex parte ROLANDO U. PAGILAGAN

Appeal No. 2001-1752

Application No. 08/636,216

Board of Patent Appeals and Interferences

2002 Pat. App. LEXIS 198

September 12, 2001, Heard

February 15, 2002, Decided

CORE TERMS: reissue, patent, copolyamide, subject matter, examiner, original patent, diamine, right to claim, original application, patentee, non-elected, composition, aliphatic, invention, recapture, correctable, hexamethylene, partially, acid, acquiesced, dicarboxylic, crystalline, consisting, aromatic, elected, divisional, inoperative, issuance, mixture, substantially identical

JUDGES: [*1] Before OWENS, WALTZ, and TIMM, Administrative Patent Judges.

OPINIONBY: TIMM

OPINION: TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the May 3, 2000 decision of the Examiner finally rejecting claims 18-20, all of the claims pending in this application for reissue of U.S. Patent 5,378,800. We have jurisdiction under 35 U.S.C. § 134.

THE ORIGINAL PATENT

The original patent, U.S. Patent 5,378,800, which Appellant seeks to reissue, matured from patent application serial number 07/917,024, issued to Appellant and then named co-inventor Mok. n1 During prosecution of the original application, the Examiner determined that there were six independent and distinct inventions and required the applicants to restrict prosecution to one of the six inventions (S.N. 07/917,024, Office Action mailed March 5, 1993, Paper No. 6, pages 2 and 3). In response, the applicants elected to prosecute claims drawn to terephthalic acid copolyamide compositions and articles and directed the cancellation of all the other claims (S.N. 07/917,024, Amendment under 37 CFR § 1.111 filed April 12, 1993, Paper No. 8, pages 1 and 2). After further prosecution, [*2] 2 U.S. Patent 5,378,800 entitled "Terephthalic Acid Copolyamides" issued from the original application on January 3, 1995 containing claims 1-11 directed only to the elected copolyamide composition and articles. The following

issued claims are representative of the subject matter secured by the original patent:

1. A partially crystalline copolyamide formed from aromatic dicarboxylic acid and aliphatic diamine, said aromatic dicarboxylic acid consisting essentially of terephthalic acid and said aliphatic diamine consisting essentially of a mixture of hexamethylene diamine and 2-methyl pentamethylene diamine, said aliphatic diamine containing at least 40%, molar basis, of hexamethylene diamine, said copolyamide having a melting point in the range of from 280 [degrees] to 330 [degrees] C:

5. A fibre formed from a partially crystalline copolyamide of claim 1.

10. A moulded article made from the partially crystalline copolyamide of claim 1.

11. A film or sheet made from the partially crystalline, copolyamide of claim 1.

n1 The Mok and Pagilagan Declaration submitted upon filing of the reissue application indicates that Mok was improperly listed as an inventor on the patent.

[*3] 3 THE REISSUE APPLICATION

Appellant filed this reissue application on April 22, 1996. At the time of filing, the reissue application contained originally patented claims 1-11 and new claims 12-15. The Declaration of Mok and Pagilagan filed with the application states that new claims 12-15 were added to cover copolyamides containing filler (Mok and Pagilagan Declaration, page 2, line 19). Before the case was taken up for examination, it became involved in an interference proceeding during which time copolyamide composition claims 16 and 17 were added (Brief, page 3). After the interference ended adversely to Appellant on December 2, 1997 and the case was returned to the Examiner (Brief, page 3), Appellant directed the cancellation of all the claims except claims 16 and 17 (Amendment filed October 4,

1996, Paper No. 6). These claims were rejected by the Examiner and, in response, Appellant cancelled claims 16 and 17 and submitted new claims 18-20 directed to a method for the formation of copolyamide (Amendment filed September 21, 1998, Paper No. 9) along with a new declaration (Pagilagan Declaration II, Paper No. 10).

THE INVENTION

Appellant describes the invention [*4] now claimed4 as a method for the formation of partially crystalline copolyamides (Brief, page 2). According to Appellant, the invention may be viewed as a two-stage method, where, in general terms, several monomers are copolymerized, the product is isolated, then is further polymerized in a second stage (*Id.*). We note that the patent refers to this process as solid state polymerization (col. 4, lines 1-4, Examples XI to XIII). The now claimed invention is adequately illustrated by claim 18:

18. A method for the formation of a partially crystalline copolyamide formed from aromatic dicarboxylic acid and aliphatic diamine, said aromatic dicarboxylic acid consisting essentially of terephthalic acid and said aliphatic diamine consisting essentially of a mixture of hexamethylene diamine, 2-methyl pentamethylene diamine, said aliphatic diamine containing at least 40% molar basis of hexamethylene diamine, said copolyamide having a melting point in the range of from 280 to 330 [degrees] C, said method comprising:

- a) feeding to a reactor an aqueous salt solution of an admixture of aromatic dicarboxylic acid and aliphatic diamine, said aromatic dicarboxylic acid consisting essentially of [*5] terephthalic5 acid and said aliphatic diamine consisting essentially of a mixture of hexamethylene diamine, 2-methyl pentamethylene diamine, said aliphatic diamine containing at least 40% molar basis of hexamethylene diamine;
- b) heating said solution under pressure until the pressure in the reactor reaches at least 1300 kPa, water and other volatile matter being vented from the reactor;
- c) when the temperature of the heated solution reaches at least 250 [degrees] C, reducing the pressure to atmospheric pressure over a period of at least 15 minutes in a manner that avoids excessive foaming of the mixture;
- d) maintaining the reaction mixture at a pressure that is not greater than about atmospheric pressure until the copolyamide has reached a predetermined molecular weight;
- e) isolating the copolyamide produced in step d); and

f) further polymerizing the isolated copolyamide at elevated temperature and under an inert atmosphere until the desired amount of polymerization is obtained.

Significantly, claims 18-20 are directed to a process for forming copolyamide and not to a copolyamide composition or article thereof as secured by the original patent. In addition, these process claims were [*6] added to the6 reissue application more than two years after the issuance of the patent.

THE REJECTION

Claims 18-20 stand rejected under 35 U.S.C. § 251 under the doctrine of improper recapture of subject matter. See the Answer at pages 2-3 for the Examiner's explanation of the rejection. As we agree with the Examiner's ultimate conclusion that the requirements of 35 U.S.C. § 251 have not been met and the Examiner's underlying reasoning supporting that conclusion, we affirm. However, we designate our affirmance as a new ground of rejection pursuant to our authority under 37 CFR § 1.196(b)(2001) based on our rewording of the statement of rejection. We restate the rejection as follows:

Claims 18-20 are rejected as improper reissue claims under 35 U.S.C. § 251 because the "error" requirement of the statute has not been met.

Furthermore, we add another rejection pursuant to our authority under 37 CFR § 1.196(b)(2001):

Claims 18-20 are rejected under 35 U.S.C. § 251, fourth paragraph because no broadening claims were applied for within the [*7] statutorily7 prescribed two year period.

OPINION

The Error Requirement

We start with the statute wherein we emphasize the pertinent portions of the "error" requirement at issue in the present case. 35 U.S.C. § 251, first paragraph (1996) states:

Whenever any patent is, through *error* without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The "error" requirement recited in the statute limits the availability of a reissue patent to certain correctable errors. Hester Indus. Inc. v. Stein Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998). Looking [*8] at the plain meaning of the statute, Genentech, Inc. v. Eli Lilly & Co., 998 F.2d 931, 941-942, 27 USPQ2d 1241, 1248 (Fed. Cir. 1993) ("The words of a statute are deemed to have their plain meaning in the lexicon of the subject matter of the legislation."), the Patent Office is authorized to reissue corrected claims only if (1) the patent is "deemed wholly or partly inoperative or invalid" by reason of the patentee claiming more or less than he had a right to claim in the patent, and (2) the defect arose "through error without any deceptive intention."

The reissue statute is grounded in the principle, articulated by Chief Justice Marshall, in Grant v. Raymond, 31 U.S. (6 Pet.) 218, 244 (1832), that a defective patent is an inadequate exchange for the patentee's disclosure of an invention and that a new patent should be issued, in appropriate circumstances, which secures to the patentee the benefits which the law intended. Hewlett-Packard Co. v. Bausch & Lomb, Inc., 882 F.2d 1556, 1565, 11 USPQ2d 1750, 1757-58 (Fed. Cir. 1989). "The reissue statute balances the [*9] purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope against the public interest in finality and certainty of patent rights." In re Graff, 111 F.3d 874, 877, 42 USPQ2d 1471, 1474 (Fed. Cir. 1997). As can be seen from reading 35 U.S.C. § 251, while the statute is remedial in nature, based on fundamental principles of equity and fairness and, therefore, to be construed liberally, not every event or circumstance that might be labeled "error" is correctable by reissue. In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986).

35 U.S.C. § 251 particularly limits, through the "error" requirement, which types of errors are correctable by reissue. Defects in the specification, drawings or claims which render the patent wholly or partly inoperative or invalid may be corrected. However, with respect to the correction of defects in claims, the patent must be "deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right [*10] to claim in the patent." In other words, limitations can be added or removed from a claim to expand or contract its subject matter so it matches what patentee had a right to claim in the original patent. No reissued claim can be obtained on subject matter which the patentee could not have secured in the original patent.

In the present case, Appellant states that the defect or "error" is one of claiming less than he had a right to

claim (Pagilagan Declaration II, page 1). The issue is whether Appellant had a right to claim in the original patent what is now claimed in the reissue application. The Federal Circuit has adopted the previously established principle that applicants are "estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent." In re Watkinson, 900 F.2d 230, 232, 14 USPQ2d 1407, 1409 (Fed. Cir. 1990), quoting In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977) (discussing In re Cornell, 150 F.2d 702, 66 USPQ 320 (CCPA 1945) [*11] and In re Smyser, 135 F.2d 747, 57 USPQ 402 (CCPA 1943)).¹¹ See also Weiler, 790 F.2d at 1582, 229 USPQ at 677.

Appellant here acquiesced to a restriction requirement by deliberately canceling all the claims not directed to the copolyamide composition and articles in response to the requirement for restriction (S.N. 07/917,024, Amendment under 37 CFR § 1.111 filed April 12, 1993, Paper No. 8, pages 1 and 2). Appellant's "right to claim" was thereby limited to the copolyamide compositions and articles elected.

The Examiner indicates that if claims 18-20 had been presented during the prosecution of the original application, these claims would have been grouped with the non-elected claims and withdrawn from consideration (Answer, page 3). Nowhere in the Brief or Reply Brief does Appellant dispute this finding. The key point is that the subject matter of claims 18-20 (method of forming copolyamide) is independent and distinct from the subject matter of the *elected* claims (copolyamide composition and articles thereof). Appellant would have had no right to examination and issuance of claims [*12] 18-20 in the original application after acquiescing in the Examiner's restriction requirement.

We also note that while Pagilagan declares that "I am entitled to claim those methods as disclosed in the specification" (Pagilagan Declaration II, page 1, lines 27-28), no details as to why he had a "right to claim" the processes described in the specification are provided. The evidence of record indicates, as discussed above, that no such entitlement exists.

After foreclosing his right to claim any subject matter other than the copolyamide composition and article elected by acquiescing in the restriction requirement and failing to file a divisional application, Appellant cannot now contend, on the present record, that his failure to include claims to the two-step process was due to an "error." Weiler, 790 F.2d at 1582, 229 USPQ at 677. Because the non-elected claims were deliberately canceled in the original application to gain allowance of the elected claims, in the absence of a

showing upon which error could be found as to the cause of his failure to claim the subject matter of claims 18-20, we must agree with the Examiner that Appellant [*13] has not established the requisite error under 35 U.S.C. § 251, first paragraph, to justify granting a reissue patent containing claims directed to the subject matter on appeal.

We note that "the reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application." Weiler, 790 F.2d at 1582, 229 USPQ at 677. Allowing Appellant to use the reissue statute to avoid a restriction requirement in which he acquiesced would defeat the purpose behind the copendency requirement of §§ 120 and 121 of the statute. Watkinson, 900 F.2d at 233, 14 USPQ2d at 1410. The "error" averred to here is simply not the type of error which is correctable through reissue.

Appellant's Arguments

Appellant appeals on the basis that the rejection is erroneous because the authority relied upon by the Examiner, i.e. MPEP §§ 1412.01 and 1412.02 and In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977), does not support the [*14] rejection and the Examiner improperly ignores differences between the claims canceled during the original prosecution and the present claims (Brief, page 4).

Appellant makes much of the Examiner's passing comments in the January 11, 2000 Office Action that "under MPEP § 1412.01 the reissue claims must be for the same invention as that of the original patent." and "under MPEP § 1412.02 a reissue will not be granted to recapture subject matter deliberately cancelled in an application to obtain a patent." Suffice it to say that we can find no reversible error by the Examiner. The facts of record support the Examiner's ultimate determination that Appellant has not averred to an "error" correctable by reissue (Answer, page 3, lines 18-21).

With respect to *Orita*, Appellant argues that "*Orita* does not apply to the present case" because claims 18-20 are not substantially identical to the non-elected claims of the original application (Brief, pages 8-9). Appellant is referring to the statement in *Orita* that "granting by reissue claims *substantially identical* to those non-elected in application I would be ignoring the proper restriction requirement set forth in that application [*15] in which appellants acquiesced." Orita, 550 F.2d at 1280, 193 USPQ at 14915 (emphasis added).

Appellant's focus on the words "substantially identical" is misplaced. Whether the claims were "substantially

identical" was not an issue in *Orita*. In that case, the claims sought to be reissued were the same as the non-elected claims presented in the original application. The case is completely devoid of any analysis with respect to differences between the two sets of claims. Rather the issue in *Orita* was whether the failure to file a divisional application was an error causing the original patent to be partially inoperative and thus correctable by reissue under 35 U.S.C. § 251. The court found such a failure to file a divisional application was not a correctable error. Orita, 550 F.2d at 1280, 193 USPQ at 148 ("In the case at bar, as in *Cornell* and *Smyser*, appellants acquiesced in the examiner's requirement for restriction. Such action manifestly was not 'error' causing patentee to claim 'less than he had a right to claim in the patent'."). *Orita* must [*16] be read as adhering to the previously established principle of *Cornell* and *Smyser*.

The facts of the present case are more similar to those of *Weiler*, a case decided by the CCPA after *Orita*, and to the facts in *Cornell* and *Smyser*, cases relied upon by the CCPA to decide *Orita*. In those cases the claims presented in the reissue application were different from any of the claims presented in the original application including those that were non-elected. The court in *Weiler* compared the situation with that of *Orita* and concluded that there is no correctable "error" even if the claims sought in reissue are vastly different from the non-elected claims of the original application. Weiler, 790 F.2d at 1582, 229 USPQ at 677 ("If it were not error to forego divisional applications on subject matter to which claims had been made in the original application [the situation in *Orita*], it cannot on the present record have been error to forego divisional applications on the subject matter to which the claims had never been made.").

Appellant's focus on differences between the reissue claims and the non-elected [*17] claims misplaces the focus of the inquiry. Whether the subject matter presented in the reissue claims is patentably distinct from the subject matter of the *non-elected* claims is not the issue. The issue is whether Appellant had a right to claim the subject matter now claimed in the original patent. It cannot be "error" to fail to include claims to subject matter which Appellant had no right to include in the first place. There was no right to claim a process in the original patent because Appellant acquiesced in a restriction requirement that limited the claims to a copolyamide composition and articles. If the Applicant cannot claim the subject matter in the original application, he has no "right to claim" it in the reissue. Weiler, 790 F.2d at 1581, 229 USPQ at 676; Cornell, 150 F.2d at 704, 66 USPQ at 322; Smyser, 135 F.2d at 751, 57 USPQ at 406. Regardless of the extent the process of claims 18-20 is similar to the process of the

non-elected claims, if Appellant had no "right to claim" the two-step process in the original patent, then [*18] he has no "right to claim" that two-step process in the reissue.

In closing we add that we choose to depart from the "recapture" language used by the Examiner for the simple reason that "recapture" has not consistently been used to describe the situation in which claims are cancelled in the original application pursuant to a restriction requirement and the applicant seeks reissue claims directed to non-elected subject matter. *Cf. In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977); *In re Cornell*, 150 USPQ 702, 66 USPQ 320 (CCPA 1945); *In re Smyser*, 135 F.2d 747, 57 USPQ 402 (CCPA 1943). While our reviewing court has made it clear that the "recapture rule" is "rooted in the 'error' requirement", *Hester Industries Inc. v. Stein Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), the cases [*19] dealing with recapture generally involve an attempt to regain subject matter originally surrendered to overcome a prior art rejection, in a somewhat different factual situation. *Cf. Hester Industries*, 142 F.3d at 1480; 46 USPQ2d at 1647-48 (Hester barred by the recapture doctrine from removing, through reissue, "solely with steam" and "two sources of steam" from the claims after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art.); *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163-64 (Fed. Cir. 1997) (Appellant is not permitted to use reissue to "recapture" the subject matter that he surrendered by amending the claims in an effort to obtain allowance of the original claims.); *see also Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993) (Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art.); *In re Byers*, 230 F.2d 451, 454, 109 USPQ 53, 55 (CCPA 1956) [*20] (deliberate amendment of a claim is not "error"). This is not to say that these cases have never been comingled, *see Watkinson*, 900 F.2d at 232, 14 USPQ2d at 1409, or that cases involving restriction have never been classified under the "recapture doctrine", *see* 4 Donald S. Chisum, *Chisum on Patents*, § 15.03[2][e], at 15-78 and n.42 (2000), it is simply to say that, in the present case, we feel that separation of the two lines of cases reduces confusion.

The Two Year Requirement

The facts of this case necessitate a second rejection which we add pursuant to our authority under 37 CFR § 1.196(b). We state the rejection as follows:

Claims 18-20 are rejected under 35 U.S.C. § 251, fourth paragraph because no broadening reissue claims were applied for within the statutorily prescribed two year period.

The fourth paragraph of 35 U.S.C. § 251(1996) states that: No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

In the present case, while Appellant applied [*21] for a reissue application within two years from the 21 grant of the original patent, that reissue application did not at that time contain claims enlarging the scope of the original patent. At the time of filing on April 22, 1996, the added claims, claims 12-15, were directed to the same copolyamide compositions of the original patented claims and included further limitations directed to the inclusion of filler. We note that, with respect to claims 12-15, the Mok and Pagilagan Declaration filed with the application indicates that "patentees do not believe that the new claims broaden the scope of the patent." (Mok and Pagilagan Declaration, page 2, line 34). We agree that claims 12-15 are not broader in scope than the original claims.

Subsequently, Appellants introduced more claims directed to the copolyamide composition, namely, claims 16-17 (Amendment filed October 4, 1996, Paper no. 6). These claims were also introduced before the expiration of the two year time window. A comparison of claim 16 with patented claim 1 reveals that the only difference between these claims is the recitation, in claim 16, of a narrower range of hexamethylene diamine concentration in the aliphatic diamine, [*22] i.e. at least 50% molar basis (claim 16) instead of at least 40% (claim 1). Claims 16 and 17 are clearly narrower in scope than the original claims.

As stated in *Graff*, 111 F.3d at 877, 42 USPQ2d at 1474: The reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance. The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent. In the present case, Appellant did not bring to public notice any broadened claims within two years of patent issuance.

Claims 18-20, herein on appeal, were filed on September 21, 1998, well after the two year time period expired on January 3, 1997. These claims are directed to a different statutory class of invention than the issued claims, namely, a process. Claims 18-20 do not merely enlarge the scope of the original claims, but stake out an entirely different territory. Here, the public was not put on notice of the patentee's intention to claim such disparate subject matter within the two

year window. Graff, 111 F.3d at 877, 42 USPQ2d at 1474. [*23] In 23 this case, we must conclude that the fourth paragraph of 35 U.S.C. § 251 forbids the issuance of claims 18-20 in this reissue application.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 18-20 under 35 U.S.C. § 251 is affirmed. Because our statement of rejection differs from that of the examiner, we denominate the affirmance as involving a new ground of rejection under 37 CFR § 1.196(b)(1997). We also add the following new ground of rejection pursuant to our authority under 37 CFR § 1.196(b):

Claims 18-20 are rejected under 35 U.S.C. § 251, fourth paragraph because no broadening reissue claims were applied for within the statutorily prescribed two year period.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice; 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial [*24] review." 24

37 CFR § 1.196(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter considered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR § 1.196(b)

TERRY J. OWENS

Administrative Patent Judge

THOMAS A. WALTZ

Administrative Patent Judge

CATHERINE TIMM

Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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